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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/820,309

04/07/2004

Tapan Chandra

132527-1

7448

23413

7590

11/13/2007

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EXAMINER

RONESI, VICKEY M

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

11/13/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/820,309

Applicant(s)

CHANDRA ET AL.

Examiner

Vickey Ronesi

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,3-17 and 19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-17 and 19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/27/2007 has been entered.
2. All outstanding objections and rejections, except for those maintained below, are withdrawn in light of applicant's amendment filed on 9/27/2007.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.

### ***Claim Rejections - 35 USC § 103***

6. Claims 1, 3-4, 6-8, 11-16, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishio et al (US 5,112,907) in view of Silvi et al (US 5,843,340, cited on IDS dated 7/22/2004).

The rejection is adequately set forth in paragraph 6 of Office action mailed on 7/12/2007 and is incorporated here by reference.

7. Claims 5, 9, 10, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishio et al (US 5,112,907) in view of Silvi et al (US 5,843,340, cited on IDS dated 7/22/2004) and further in view of Bastiaens et al (US 6,353,050, cited on IDS dated 7/22/2004).

The rejection is adequately set forth in paragraph 7 of Office action mailed on 7/12/2007 and is incorporated here by reference.

### ***Response to Arguments***

8. Applicant's arguments filed on 9/27/2007 have been fully considered but they are not persuasive. Specifically, applicant argues (A) Nishio does not disclose amounts of adhesion promoter of 0.5-2.5 and cites col. 4, lines 40-48 where Nishio teaches modified copolymer rubber is used in amounts of 5-100 parts by weight per 100 parts by weight of the composition and (B) that criticality has been established for adhesion promoter in amounts of less than 2.5 wt %.

With respect to argument (A), it is noted that the modified copolymer rubber of Nishio is not considered to be the adhesion promoter. Rather, it is the epoxy compound which is present in an amount of 1-30 wt % (col. 6, line 68 to col. 7, line 1) that is considered to be the adhesion promoter in the prior art rejections of record. It is well settled that where the prior art describes the components of a claimed compound or compositions in concentrations within or overlapping the claimed concentrations a prima facie case of obviousness is established. See *In re Harris*, 409 F.3d 1339, 1343, 74 USPQ2d 1951, 1953 (Fed. Cir 2005); *In re Peterson*, 315 F.3d 1325, 1329, 65 USPQ 2d 1379, 1382 (Fed. Cir. 1997); *In re Woodruff*, 919 F.2d 1575, 1578 16

USPQ2d 1934, 1936-37 (CCPA 1990); *In re Malagari*, 499 F.2d 1297, 1303, 182 USPQ 549, 553 (CCPA 1974).

With respect to argument (B), the data has been considered, however, it fails to establish criticality for the claimed range of 0.5-2.5 wt % adhesion promoter for three reasons. First, the data only compares 1 wt % to 3 wt % and cannot establish criticality for an upper limit of 2.5 wt %. Second, the data is not reasonably commensurate in scope with the scope with claims given that the exemplified adhesion promoters only include Vancryl 68 (styrene-acrylic acid copolymer), Primacor 5990I (ethylene-acrylic acid copolymer), and ECN (epoxy-cresol-novolac). Case law holds that evidence is insufficient to rebut a *prima facie* case if not commensurate in scope with the claimed invention. *In re Grasselli*, 713 F.2d 731, 741, 218 USPQ 769, 777 (Fed. Cir. 1983). Furthermore, case law holds that evidence of superior properties in one species insufficient to establish the nonobviousness of a subgenus containing hundreds of compounds. *In re Greenfield*, 571 F.2d 1185, 1189, 197 USPQ 227, 230 (CCPA 1978). Third, the data appears to be incongruous since the examples with 3 wt % so-called "adhesion promoter" have a lower peel strength than the example with no adhesion promoter.

### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vicky Ronesi whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

11/6/2007  
Vickey Ronesi



/Vasu Jagannathan/  
Supervisory Patent Examiner  
Technology Center 1700